

REMARKS

This Application has been carefully reviewed in light of the Final Office Action dated May 25, 2007 ("*Final Office Action*"). In the *Final Office Action*, Claims 1-39 are pending. The Examiner rejects Claims 1-13, 15-21, and 23-39; and objects to Claims 14 and 22. Applicants amend Claims 1, 16, and 32. Applicants submit that no new matter has been added by these amendments. Applicants respectfully request reconsideration and favorable action in this case.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that Claims 14 and 22 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims. However, as discussed below, Applicants believe that independent Claim 11 (from which Claim 14 depends) and independent Claim 16 (from which Claim 22 depends) are also allowable. Therefore, Applicants have not amended Claims 14 and 22.

Section 103 Rejections

The Examiner rejects Claims 1-13, 15-21, and 23-39 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of U.S. Patent Application Publication No. 2003/0061319 issued to Manzardo ("*Manzardo*"), U.S. Patent No. 7,085,805 issued to Ruberg et al. ("*Ruberg*"), U.S. Patent No. 6,853,714 issued to Liljestrand et al. ("*Liljestrand*"), U.S. Patent No. 6,785,223 issued to Korpi et al. ("*Korpi*"), and U.S. Patent No. 7,023,876 issued to Berry et al. ("*Berry*").

A. The Claims are Allowable over the cited References

Because the proposed combinations do not disclose, teach, or suggest the features of Applicants' claims, Applicants respectfully traverse the rejection of the claims and request reconsideration and favorable action.

1. Claims 1-2, 4, 16-18, 21, 23, 32, 33, and 35

In the *Final Office Action*, the Examiner maintains the rejection of Claims 1-2, 4, 16-18, 21, 23, 32, 33, and 35 over the *Manzardo-Ruberg* combination. It continues to be Applicants' position, however, that the proposed *Manzardo-Ruberg* combination does not disclose the particular combination of features and operations recited in Applicants' claims.

In the previous Response to Office Action submitted on March 9, 2007, Applicants identified, as examples, several claim elements that were not disclosed in the proposed *Manzardo-Ruberg* combination. Although Applicants believe that those previous arguments continue to have merit, to avoid burdening the record, Applicants do not repeat those arguments here. Rather, Applicants refer the Examiner to pages 11-14 of the previous Response to Office Action for a detailed discussion of the failure of the proposed *Manzardo-Ruberg* combination to disclose, teach, or suggest Applicants' steps of "maintaining a connection with the second user endpoint after the interruption" and "reestablishing the communication session between the first user endpoint and the second user endpoint if the keep alive signals resume within a predetermined time period," as recited in Claim 1 and as analogously recited in independent Claims 16 and 32.

Additionally, Applicants submit that the proposed *Manzardo-Ruberg* combination does not disclose, teach, or suggest "determining that the interruption in keep alive signals resulted from failure of the first user endpoint and not as a result of voluntary disconnection," as recited in amended Claim 1. Although *Manzardo* discloses keep alive signals, such keep alive signals are initiated by a server. Specifically, the system of *Manzardo* includes a main server 102 and a stand-by server 104. According to *Manzardo*, "the main server 102 provides or at least initiates at least one signal that is provided or sent directly or indirectly to the stand-by server 104, referred to herein as "keep alive" signal, that indicates the main server 102 is operational, available, or otherwise providing support for calls." (*Manzardo*, Page 5, paragraph 45, lines 1-6). Thus, the "keep alive signals" disclosed in *Manzardo* are initiated by the main server and are transmitted to the stand-by server to indicate that the main server is operational. There is no disclosure in *Manzardo*, however, of "determining that the interruption in keep alive resulted from failure of the first user endpoint and not as a result of voluntary disconnection," as recited in Claim 1. The recited features are absent from *Manzardo*.

Ruberg does not cure the deficiencies of *Manzardo* identified above. *Ruberg* merely discloses that “a heartbeat message may be sent in both directions between the peer device managers and in both directions between each device manager and their respective desktop units.” (*Ruberg*, Column 15, lines 18-21). “After a predetermined number of heartbeat time periods have expired without hearing anything, functionality of the remote unit *may be assumed to be non-functional* and the connections between the local and the remote units may be closed.” (*Ruberg*, Column 15, lines 25-29). By contrast, “[i]f desktop unit 386 recovers within the heartbeat time period, device manager 366 never learned that desktop unit 386 has failed and thus continues to think that it owns the device.” (*Ruberg*, Column 15, 45-48). Thus, according to *Ruberg*, if a missed heartbeat is detected the connection is closed, but if a heartbeat is never missed (because recovery is within less than a heartbeat time period) the connection continues. Since the device manager never knows of the failure, there can be no disclosure in *Manzardo* that the device manager “determines that the interruption in keep alive resulted from failure of the first user endpoint and not as a result of voluntary disconnection,” as recited in Claim 1.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1, together with Claims 2 and 4 that depend from Claim 1.

Independent Claims 16 and 32 includes certain features and operations that are analogous to the features and operations recited in Claim 1. For example, Claim 16 recites “a processor operable to . . . determine that the interruption in keep alive signals resulted from failure of the first user endpoint and not as a result of a voluntary disconnection by a user of the first endpoint.” Claim 32 recites “determining that the interruption in keep alive signals resulted from failure of the first user endpoint and not as a result of a voluntary disconnection by a user of the first endpoint.” Accordingly, for reasons analogous to those discussed above with regard to Claim 1, Applicants submit that the proposed *Manzardo-Ruberg* combination does not disclose, teach, or suggest the features of independent Claims 16 and 32. For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 16 and 32, together with Claims 17-18, 21, and 23 that depend on Claim 16 and Claims 33 and 35 depending from Claims 16 and 32, respectively.

2. Claims 6-7, 26, 28-29, 31, 36, 37, and 39

In the *Final Office Action*, the Examiner maintains the rejection of Claims 6-7, 26, 28-29, 31, 37, and 39 over the *Manzardo-Ruberg* combination. It continues to be Applicants' position, however, that the proposed *Manzardo-Ruberg* combination does not disclose the particular combination of features and operations recited in Applicants' claims.

In the previous Response to Office Action submitted on March 9, 2007, Applicants identified, as examples, several claim elements that were not disclosed in the proposed *Manzardo-Ruberg* combination. Although Applicants believe that those previous arguments continue to have merit, to avoid burdening the record, Applicants do not repeat those arguments here. Rather, Applicants refer the Examiner to pages 11-16 of the previous Response to Office Action for a detailed discussion of the failure of the proposed *Manzardo-Ruberg* combination to disclose, teach, or suggest Applicants' steps of "maintaining a connection with the second user endpoint after the interruption," as recited in Claim 6 and as analogously recited in independent Claims 26, and 39.

Additionally, Applicants submit that the proposed *Manzardo-Ruberg* combination does not disclose, teach, or suggest "transferring the communication session with the second user endpoint from the first user endpoint to a third user endpoint," as recited in Claim 6. In the *Final Office Action*, the Examiner relies upon *Manzardo* for the operational step of "transferring the communication session" but acknowledges that "*Manzardo* does not expressly disclose a user endpoint." (*Final Office Action*, pages 4-5). Instead, the Examiner relies upon *Ruberg* for disclosure of the user endpoint. Applicants respectfully submit that such a piecemeal rejection of Applicant's claim fails to give credence to the overall combination of features recited in the Claim 6. The M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Applicants' claim does not merely recite transferring a communication session. Additionally, Applicants' claim does not recite "a user endpoint" in the abstract. Rather, Applicants' Claim 6 clearly recites "transferring the communication session with the second user endpoint from the first user endpoint to a third user endpoint." This combination of elements is absent from the *Manzardo-Ruberg* combination.

Although *Manzardo* discloses that the stand-by server 104 may initiate a switch over from the main server 102 to the stand-by server 104 if the stand-by server 104 fails to receive one or more of the keep alive signals (*Manzardo*, Page 5, paragraph 49), the switch-over between two servers that support a call is not analogous to Applicants' step of "transferring the communication session with the second user endpoint from the first user endpoint to a third user endpoint," as recited in Claim 6. Similar to *Manzardo*, *Ruberg* also "relates to methods and apparatus for data distribution among servers in a grouped server system where device operations remain uninterrupted when a server fails." (*Ruberg*, Column 2, lines 18-20). Thus, neither *Manzardo* nor *Ruberg* relate to or suggest "transferring the communication session with the second user endpoint from the first user endpoint to a third user endpoint," as recited in Applicants' Claim 6. Applicants respectfully submit that a rejection of Claim 6 under the proposed *Manzardo-Ruberg* combination, in the manner provided by the Examiner, can only result from the piecing together of disjointed portions of the references to reconstruct Applicants' claims.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 6, together with Claim 7 that depends from Claim 6.

Independent Claims 26 and 39 include certain features and operations that are analogous to the features and operations recited in Claim 1. For example, Claim 26 recites "a processor operable to . . . transfer the communication session with the second user endpoint to a third user endpoint." As another example, Claim 36 recites "transferring the communication session with the second user endpoint from the first user endpoint to a third user endpoint." As still another example, Claim 39 recites "means for transferring the communication session with the second user endpoint to a third user endpoint." Accordingly, for reasons analogous to those discussed above with regard to Claim 6, Applicants submit that the proposed *Manzardo-Ruberg* combination does not disclose, teach, or suggest the features of independent Claims 26, 36, and 39.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 26, 36, and 39, together with the Claims 28-29 and 31 that depend from Claim 26 and Claim 37 that depends from Claims 36.

3. Claims 11-13 and 15

In the *Final Office Action*, the Examiner maintains the rejection of Claims 11-13 and 15 over the *Manzardo-Berry* combination. It continues to be Applicants' position, however, that the proposed *Manzardo-Berry* combination does not disclose the particular combination of features and operations recited in Applicants' claims.

For example, the proposed *Manzardo-Berry* combination does not disclose, teach, or suggest the steps of "receiving from a user of the first user endpoint a user-generated message to reestablish the communication session" and "in response to the user-generated message, reestablishing the communication session between the second user endpoint and the user of the first user endpoint," as recited in Applicants' Claim 11. In the *Final Office Action*, the Examiner again acknowledges that the recited features and operations are absent from *Manzardo* and continues to rely upon *Berry*. As previously shown by Applicants, however, the portions of *Berry* cited by the Examiner in the *Final Office Action* (and the previous Office Action) indicate that it is the state machine 204 of the *Berry* system that initiates the messages. Specifically, *Berry* discloses that "the state machine 401 provides a set response mode message to the protocol layer 103 that causes the protocol layers 102 and 103 to begin the initialization process and re-negotiate the exchange rate and re-establish the connection." (Column 9, lines 35-39). *Berry* further discloses that "state machine 401 provides a synchronization request message to re-establish the connection and/or renegotiate the exchange rate." (Column 13, lines 51-53). Thus, the relied upon portions of *Berry* merely disclose that a state machine 401 initiates various messages during the negotiation of an exchange rate and the (re)establishment of a connection. (Abstract). Because *Berry* discloses that the state machine initiates the messages, Applicants maintain that there is no disclosure in the cited portions of *Berry* of "a user-generated message," as recited in Claim 11. Since *Berry* does not disclose a user-generated message, *Berry* cannot possibly disclose, teach, or suggest "receiving **from a user** of the first user endpoint a **user-generated** message to reestablish the communication session," as recited in Claim 11. For analogous reasons, *Berry* also does not disclose, teach, or suggest "**in response to the user-generated message**, reestablishing the communication session between the second endpoint and the user of the first endpoint," as also recited in Claim 11.

In the *Final Office Action*, the Examiner answers by directing Applicants to Column 5, lines 51-55 of *Berry*. (*Final Office Action*, page 20). That portion of *Berry* mere discloses, however:

The devices, 100 and 101, could be any devices where point-to-point digital communication exchange is desired. Some examples of the devices, 100 and 101, include without limitation, tape drives, hard drives, tape library systems, notebook computers, desktop computers, and workstations.

(*Berry*, Column 5, lines 51-55). Thus, the cited portion merely describes the types of devices that may communicate by way of the point-to-point protocol of *Berry*. The cited portion does not disclose Applicants' recited claim elements. Perhaps anticipating that the cite portion of *Berry* is deficient, the Examiner further states in the *Final Office Action* that "*Berry* inherently teaches: a user generated message" and "receiving from a user of the first user endpoint a user-generated message to reestablish the communication session," as recited in Claim 11." (*Final Office Action*, page 21). Applicants respectfully disagree.

The M.P.E.P. provides guidance with regard to when a characteristic is inherently disclosed in a prior art reference. Specifically, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (*emphasis original*)). Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP § 2112 (citing *Ex Parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis original*)).

In the instant case, there is no indication in *Berry* that the allegedly inherent characteristics (i.e., receiving from a user of the first user endpoint a user-generated message to reestablish the communication session and in response to the user-generated message, reestablishing the communication session between the second user endpoint and the user of the first user endpoint) necessarily flows from the teachings of *Berry*. In fact, and as identified by Applicants above, *Berry* actually discloses that a state machine 401 initiates various messages

during the negotiation of an exchange rate and the (re)establishment of a connection. (Abstract). Although devices 100 and 101 are described as using the point-to-point protocol of *Berry*, there is no disclosure in *Berry* that a user of the device is involved in the negotiation of the exchange rate. Rather, the negotiation of an exchange rate and the establishment of a connection for a communication exchange typically occurs without any user interaction at all. Accordingly, Applicants claim language reciting “receiving from a user of the first user endpoint a user-generated message to reestablish the communication session” and “in response to the user-generated message, reestablishing the communication session between the second user endpoint and the user of the first user endpoint” is not inherently disclosed by *Berry* or the proposed *Manzardo-Berry* combination.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 11, together with Claims 12-13 and 15 that depend from Claim 11.

B. The Proposed *Manzardo-Ruberg* and *Manzardo-Berry* Combinations are Improper

Furthermore, Applicants respectfully submit that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Manzardo* with *Ruberg* and/or *Berry* in the manner the Examiner proposes. Applicants' claims are allowable for at least this additional reason.

1. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Manzardo-Ruberg* and *Manzardo-Berry* combinations do not, taken as a whole, suggest the claimed invention, taken as a whole. Applicants respectfully submit that the Examiner has

merely pieced together disjointed portions of references, with the benefit of hindsight using Applicants' claims as a blueprint, in an attempt to reconstruct Applicants' claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* ***Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, ***"The tendency to resort to 'hindsight' based upon applicant's disclosure is***

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. The Analysis

a. The *Manzardo-Ruberg* Combination is Improper

With regard to Claim 1, the Examiner states that "one skilled in the art would have recognized the reestablishing the communication session between the first endpoint and the

second endpoint if the keep alive signals resume within a predetermined time period, and would have applied *Ruberg et al.*'s desktop unit recovery in *Manzardo*'s establishing a communication session.” (Office Action, page 3). The purported motivation provided by the Examiner is that “recovery is accomplished in less than a heartbeat time period.” (Office Action, page 3). The Examiner makes similar statements with regard to Claims 16, 23, and 29. With regard to Claim 6, the Examiner states that “[o]ne skilled in the art would have recognized the user endpoint and would have applied *Ruberg et al.*'s computer 50 in *Manzardo*'s establishing a communication session.” (Office Action, page 5). The purported motivation provided by the Examiner is “to introduce user input to computer system 60 (col. 3, line 55).” (Office Action, page 5).

It appears that the Examiner has merely proposed alleged advantages of combining *Manzardo* with *Ruberg* (advantages which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portions of *Ruberg* that touts advantages of its system, the Examiner has not pointed to any portions of the cited reference that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the communication system supporting IP network calls disclosed in *Manzardo* with the periphery device management services provided to a desktop as disclosed in *Ruberg*. In other words, the alleged advantage of the systems disclosed in *Ruberg* do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention (*without using Applicants' claims as a guide*) to modify the cited disclosure in *Manzardo* to include the particular techniques disclosed in *Ruberg*; (2) how one of ordinary skill in the art at the time of Applicants' invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicants' claims. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Furthermore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the

communication system supporting IP network calls disclosed in *Manzardo* with the periphery device management services provided to a desktop as disclosed in *Ruberg*.² In the Office Action, the Examiner has stated that *Ruberg* is analogous art. As described above, however, *Manzardo* relates to a system providing switch over “from a main server to a stand-by server for supporting or facilitating calls having traffic routed across an IP network when the main server is disrupted or becomes unavailable.” (*Manzardo*, Abstract). By contrast, *Ruberg* relates to a system that allows a desktop unit (i.e., computer) to maintain persistent connections with a single device manager” even when the desktop unit or device manager fails. (*Ruberg*, column 2, lines 18-38). While *Manzardo* relates to a communication system, *Ruberg* relates to a very different networked computer system.

Applicants find no reason in *Manzardo* or *Ruberg* as to why one of ordinary skill in the art would be motivated to combine these seemingly unrelated references in the manner proposed by the Examiner for the reasons proposed by the Examiner. One of ordinary skill in the art at the time of Applicants’ invention would have considered the references as relating to different fields of invention and would not made the proposed combination. Applicants respectfully submit that a rejection of Applicants’ claims under the proposed *Manzardo-Ruberg* combination, in the manner provided by the Examiner, can only result from the piecing together of disjointed portions of unrelated references to reconstruct Applicants’ claims. Accordingly, Applicants respectfully submit that the Examiner’s attempt to modify or combine the proposed references appears to constitute the type of impermissible hindsight reconstruction of Applicants’ claims, using Applicants’ claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Manzardo* with *Ruberg* in the manner the Examiner proposes, Applicants respectfully submits that the Examiner’s conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case

² If “common knowledge” or “well known” art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1-12 and 15-39.

b. The *Manzardo-Berry* Combination is Improper

With regard to Claim 11, the Examiner states that “[o]ne skilled in the art would have recognized the receiving from a user of the first endpoint a message to reestablish the communication session, and in response to the message, reestablishing the communication session between the second endpoint and the user of the first endpoint, and would have applied *Berry et al*’s re-establish the connection in *Manzardo*’s establishing a communication session.” (Office Action, page 17). The purported motivation provided by the Examiner is “to re-establish the connection.” (Office Action, page 17).

Again, it appears that the Examiner has merely proposed alleged advantages of combining *Manzardo* with *Berry* (advantages which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portions of *Berry* that tout an advantage of its system, the Examiner has not pointed to any portions of the cited reference that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the communication system supporting IP network calls disclosed in *Manzardo* with the exchange rate re-negotiation functionality of *Berry*. In other words, the alleged advantage of the system disclosed in *Berry* do not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants’ invention (*without using Applicants’ claims as a guide*) to modify the cited disclosure in *Manzardo* to include the particular techniques disclosed in *Berry*; (2) how one of ordinary skill in the art at the time of Applicants’ invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicants’ claims. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case

law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Furthermore, it certainly would not have been obvious to one of ordinary skill in the art at the time of invention *to even attempt* to, let alone *to actually*, modify or combine the communication system supporting IP network calls disclosed in *Manzardo* with the exchange rate re-negotiation functionality of *Berry*.³ In the Office Action, the Examiner has stated that *Berry* is analogous art. As described above, however, *Manzardo* relates to a system providing switch over “from a main server to a stand-by server for supporting or facilitating calls having traffic routed across an IP network when the main server is disrupted or becomes unavailable.” (*Manzardo*, Abstract). By contrast, *Berry* relates to an application program for “request[ing] renegotiation of an exchange rate at any time.” (*Berry*, Abstract). Aside from relating very generally to communication services, Applicants find no reason in *Manzardo* or *Berry* as to why one of ordinary skill in the art would be motivated to combine these seemingly unrelated references in the manner proposed by the Examiner for the reasons proposed by the Examiner. One of ordinary skill in the art at the time of Applicants’ invention would have considered the references as relating to different fields of invention and would not made the proposed combination. Applicants respectfully submit that a rejection of Applicants’ claims under the proposed *Manzardo-Berry* combinations, in the manner provided by the Examiner, can only result from the piecing together of disjointed portions of unrelated references to reconstruct Applicants’ claims. Accordingly, Applicants respectfully submit that the Examiner’s attempt to modify or combine the proposed references appears to constitute the type of impermissible hindsight reconstruction of Applicants’ claims, using Applicants’ claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Manzardo* with *Berry* in the manner the Examiner proposes, Applicants respectfully submits that the Examiner’s conclusions set forth in the Office Action do not meet

³ If “common knowledge” or “well known” art is relied upon by the Examiner to combine or modify the references, Applicant respectfully requests that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicant respectfully requests that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 1-13 and 15-39.

CONCLUSION

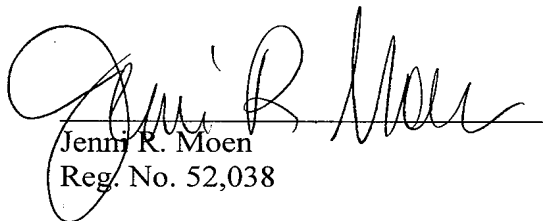
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorneys for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants believe that no fees are due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

BAKER BOTTS, L.L.P.
Attorneys for Applicants



Jenni R. Moen
Reg. No. 52,038

Date: July 17, 2007

Correspondence Address:

at Customer No. **05073**